## REMARKS

Claims 1-40 are pending. Claims 4-7 are amended.

The Examiner stated that applicant had not complied with the requirements for claiming priority under 35 U.S.C. § 120; rejected claims 1-7, 9, 10, 12, 13, 17-19, 23-28, 30, 32-36, and 40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication 2002/0131071 to Parry et al. (Parry); rejected claims 8, 14-16, 29, and 39 under 35 U.S.C. § 103 as being unpatentable over Parry in view of U.S. Patent Publication 2002/0135800 to Dutta (Dutta); rejected claims 11, 20-22, 37, and 38 under 35 U.S.C. § 103 as being unpatentable over Parry in view of U.S. Patent Publication 2003/0041102 to Bozdagi (Bozdagi). The Examiner has failed to reject claim 31 under prior art.

Applicants disagree with the Examiner that the parent '453 and '560 applications lack support for at least one of the pending claims under § 120. If applicants can show support for at least one claim of the subject application in the '453 application, the priority claim is proper.

Claim 1 of the subject application recites:

1. A method, comprising:

receiving, by a printer, a document having a pointer pointing to data that is not in the received document; and

creating by the printer, in response to receipt of the document, a printable document in accordance with the pointer.

<u>Support in the '453 application</u>

Claim 1, for example, is supported in U.S. Serial No. 09/728,453 ("the '453 application"). The '453 application discloses an adaptor that receives multimedia information, stores it, and forwards it to output devices, including a printer (see, Fig.

2 showing a user interface output device 210, which may be a printer (para. 47)). Paragraph 91 of the '453 application states:

Claim 11 of the '453 application supports receiving, by a device such as a printer, a document having a pointer (e.g., a URL, as recited in applicants' claim 10) to data that is not in the received document. Claim 11 recites (emphasis added):

11. The method of claim 10: wherein processing the multimedia presentation information received from the first source and the information received from the second source to generate the first representation further comprises: generating a web page for each video frame in the plurality of vide frames, each web page including a video frame; **assigning a uniform resource locator (URL) to each web page; and wherein transmitting at least a portion of the first representation to the device comprises transmitting at least one URL assigned to a web page to the device.**

Claim 12 of the '453 application supports "c reating by the printer, in response to receipt of the document, a printable document in accordance with the pointer." Claim 12 recites (emphasis added):

12. The method of claim 11 wherein transmitting at least a portion of the first representation to the device comprises: **receiving, at the adapter, a request from the device comprising a first URL; in response to the request, determining a first web page corresponding to the first URL; and transmitting the first web page to the device.**

Thus, the ' 453 application supports receiving by a device, such as a printer, a URL representing multimedia presentation information (such as frozen video frames; see, e.g., claim 10 of the '453 application), an d having the printer send a further request for information referred to by the URL so that the content referred to by the URL can be processed (e.g., printed). Applicants contend therefore that the '453 application supports at least one claim of the subject application and that the claimed priority to the '453 application under 35 U.S.C. § 120 is proper.

Claims 19, 32, and 40 are supported by the '453 application for similar reasons.

Support in the '560 Application

Claim 1, for example, is supported in U.S. Serial No. 09/728,560 ("the '560 application"). The '560 application discloses

[0035] User interface output devices 210 may include a display subsystem, a **printer**, a fax machine, or non-visual displays such as audio output devices. The display subsystem may be a cathode ray tube (CRT), a flat-panel device such as a liquid crystal display (LCD), or a projection device. The display subsystem may also provide non-visual display such as via audio output devices. In general, use of the term "output device" is intended to include all possible types of devices and ways to output information from computer system 200. These output devices may be used to receive status information and other feedback information from computer system 200. (emphasis added).

The '560 application also states:

[0083] As described above, according to an embodiment of the present invention, information related to each individual presentation may be stored in HTML format that is derived from the SMIL format. According to this embodiment, **the HTML may include thumbnail images of the keyframes and links to other media types,** and computational methods that enable various communication methods.

Thus, the '560 application supports receiving by a device, such as a printer, a document (such as html representing frozen video frames; see, e.g., Fig. 4 of the '560 application) and having the printer send a further request for information referred to by the URL so that the content referred to by the URL can be processed (e.g., printed). Applicants contend therefore that the 560 application supports at least one claim of the subject application and that the claimed priority to the '560 application under 35 U.S.C. § 120 is proper.

*8421*                                     -9-

Claims 19, 32, and 40 are supported by the '560 application for similar reasons.

Although the Examiner mentioned 35 U.S.C. § 119(e) in the form paragraph in the Office Action, he did not explicitly state that applicants' priority claims under 35 U.S.C. § 119(e) were insufficient. Applicants, therefore, have not addressed these priority claims herein. If the Examiner has questions concerning support in the parent provisional applications for the subject application, he is invited to contact the undersigned.

The Examiner rejected claims 1-7, 9, 10, 12, 13, 17-19, 23-28, 30, 32-36, and 40 under 35 U.S.C. § 102(e) as being anticipated by Parry. The rejected claims include independent claims 1, 19, 32, and 40. Applicants' arguments above in support of applicants' priority cl aim remove Parry as a reference for independent claims 1, 19, 32, and 40 and their respective dependent claims, because the '453 a nd '560 applications were filed in 2000, prior to Parry's date. Applicants a ddress representative ones of the Examiner's rejections of the dependent c laims below.

Claims 3-7, as amended recite that the printable document contains both the data not in the received document and the barcode. Because Parry merely discloses printing the barcode when the barcode does not contain a URL pointing to a document, claims 3-7 as amended patentably distinguish over Parry.

The Examiner rejected claims 8, 14-16, 2, and 29 under § 103 as being unpatentable over Parry in view of Dutta. The Examiner further rejected claims 11, 20-22, 37, and 38 under § 103 as being unpatentable over Parry in view of Bozdagi.

Because Dutta and Bozdagi fail to correct the deficiencies of Parry, these dependent claims are patentably distinct for at least the same reasons as their independent claims.

On the basis of the above amendment and remarks, consideration of this application and the early allowance of all claims herein are requested.

Should the Examiner wish to discuss the above remarks, or if the Examiner believes that for any reason direct contact with Applicants' representative would help to advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

Dated: __April 29, 2006__

By: _____

Laura A. Majerus
Reg. No. 33,417
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
(650) 938-5200